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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:	KEITH ROBINSON	EXAMINER:	RUSSELL MARC KOBERT
APPLICATION NO.:	10/775,394	ART UNIT:	2829
FILED:	FEBRUARY 10, 2004	CONF. NO:	8893
FOR:	**LOAD BOARD SOCKET ADAPTER AND INTERFACE METHOD**		

Response to Restriction Requirement

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In the Office Action dated October 4, 2004, the Examiner divided the claims into the following species:

(a) The species to which claims 17-23 are drawn;

(b) The species to which claims 24-31 are drawn; and

(c) The species to which claims 32-36 are drawn;

The Examiner never explains how the species are independent or distinct, nor even argues that examination of all 20 claims in the application on its merits would place a serious burden on the Examiner.

Restriction, a generic term, includes the practice of requiring an election between distinct inventions, for example, election between combination and subcombination inventions, and the practice relating to an election between independent inventions, for example, and election of species. MPEP § 802.02. If the search and examination of an entire application can be made **without serious burden**, the examiner **must** examine it on the merits, even though it includes claims to independent or distinct inventions. MPEP § 803; *Emphasis added.* MPEP § 803 goes on to state that

"[e]xaminers **must** provide reasons and/or examples to support conclusions, but need not cite documents to support the restriction requirement in most cases." *Emphasis added.* MPEP § 808 states that "[e]very requirement to restrict has two aspects: (A) **the reasons** (as **distinguished from the mere statement of conclusion**) why the inventions *as claimed* are either **independent or distinct**; **and** (B) **the reasons** for **insisting upon restriction** therebetween . . ." *Emphasis added.*

MPEP § 808.02 goes on to state:

> Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 U.S.C. 121 is never proper (MPEP § 806.05). If applicant optionally restricts, double patenting may be held.
>
> Where the related inventions as claimed are shown to be distinct under the criteria of MPEP § 806.05(c) - § 806.05(i), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:
>
> (A) **Separate classification thereof**: This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.
>
> (B) **A separate status in the art when they are classifiable together**: Even though they are classified together, each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.
>
> (C) **A different field of search**: Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.
>
> **Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate**

future classification and field of search, no reasons exist for dividing among related inventions.

Emphasis added.

Accordingly, in order to require an election, the Examiner must provide the rationale for both making the restriction requirement and insisting on the restriction requirement. Additionally, in order for the Examiner to issue a restriction requirement, examination of all 20 claims in the application must place a serious burden on the Examiner. None of these requirements have been met in the present Office Action. Instead, the Examiner has **merely made a statement of conclusion** that the grouped claims represent separate species. Accordingly, the restriction requirement is improper. The Examiner should either remove the restriction requirement or fully comply with the MPEP in requiring an election.

Furthermore, if the present restriction requirement stands without the Examiner providing the rationale **required** by the MPEP to issue the restriction requirement, the undersigned will be unable to comply with MPEP §§ 801 and 809.02(a) if/when claims are added during prosecution. The examiner has not provided the reasons for issuing the restriction requirement, explained how or why the claims have been grouped in to the three listed species, or suggest how the species have been divided. Accordingly, the undersigned does not know the basis the Examiner has used to divide the species. If claims are added during prosecution, it would therefore be impossible for the undersigned to identify which added claims are readable on the selected species as required by the MPEP.

Because the undersigned is required to make an election in order for this communication to be responsive, the undersigned provisionally elects claims 32-36 for prosecution. However, in light of the foregoing, the undersigned respectfully requests that the Examiner either remove the restriction requirement or fully comply with the MPEP in requiring this election.

No fees are believed due with this communication. However, the Commissioner is hereby authorized and requested to charge any deficiency in fees herein to Deposit Account No. 50-0665.

Respectfully submitted,

Perkins Coie LLP

Date: October 19, 2004

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